

### **REMARKS**

By the present amendment, applicants have amended claims 10, 16, and 23, and canceled claims 12, 15 and 17. No new matter has been introduced by these amendments. Accordingly, claims 10, 16, and 18-24 are under examination.

### **Interview Summary**

Applicants thank Examiner Robinson and Examiner Grunberg for their time and courtesy extended to Applicants, namely Dr. Nicolas C.M.H de Vetten and Lauren T. Emr, during a telephonic interview on September 2, 2010. The rejections of claims 10, 15, 16 and 23 were discussed.

Applicants thank the Examiners for discussing/suggesting amendments to the claims that would more clearly express the invention. Specifically, it was discussed that a homozygous state with regards to the *amf*-allele is required to achieve an increase in protein content.

The Interview Summary that was mailed on September 8, 2010 is accurate and complete.

### **Rejections Under §112, Second Paragraph**

In the office action, claims 15 and 23 have been rejected as allegedly being indefinite. Claim 15 has been rejected for depending on a cancelled claim, and claim 23 for reciting the word “providing” which allegedly is not defined by the claim or specification.

In response, applicants have cancelled claim 15 and amended claim 23. Claim 23 now recites that the method of claim 16 has a further step of transforming selected progeny with a gene encoding a heterologous protein.

Applicants respectfully request reconsideration and withdrawal of the above rejections.

### **Rejection under 35 U.S.C. § 103(a)**

In the office action, claims 10, 12 and 15-24 continue to be rejected as allegedly being unpatentable under §103(a) in view of Jacobsen (*Euphytica* 44:43-48, 1989), Jacobsen (*Euphytica* 53:247-253, 1991), Pochlman ("Breeding Potato," *Breeding Field Crops*, Chapter 21, pp. 419-433, 1995), and Farran (*Transgenic Research* 11:337-346, 2002).

As discussed during the interview, none of the cited references provide any nexus between an allele relating to amylose-free starch and protein content and/or storage capacity, or a nexus between any allele relating to starch and protein content and/or storage capacity.

In response, Applicants have amended the claims to more clearly recite the invention. Specifically, the claims now require that a first parent potato plant having at least one *amf*-allele is crossed with a second parent potato plant having at least one *amf*-allele to produce progeny. The progeny is then selected and tested for the presence of at least one *amf*-allele and for increased protein content. Finally, progeny being homozygous for the *amf*-allele with protein content higher than a plant heterozygous for the *amf*-allele are selected.

None of the cited documents disclose or suggest the above method. Therefore, Applicants respectfully request reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a).

### **Conclusion**

In view of the foregoing amendments and remarks, entry of the amendments and favorable consideration of the claims are respectfully requested. If the examiner has any questions or concerns regarding this amendment, he is invited to contact the undersigned at the telephone number listed below.

If any fees are due or any over overpayment made in connection with this submission, please charge or credit our Deposit Account No.: 08-2461 for such sum.

Respectfully submitted,

/lauren t. emr/

Lauren T. Emr

Registration No.: 46,139

Attorney for Applicants

HOFFMANN & BARON, LLP  
6900 Jericho Turnpike  
Syosset, New York 11791  
(516) 822-3550  
LTE/aca